

## **DETAILED ACTION**

### **Claim Status**

1. Amendment filed on December 10, 2008 is acknowledged. Applicant has amended claims 1, 4 and 5. Claims 1-5 are currently pending and will be examined in this action.

### ***Priority***

2. Certified English translation of Parent Korean application KR 10-2004-0052652 filed on July 7, 2004 has been received. Accordingly Applicant has perfected the priority dated July 7, 2004.

### ***Response to Amendment and Arguments***

#### ***Re 112 1<sup>st</sup> written description rejection of claims 1-5***

3. Applicant's arguments, filed December 10, 2008, with respect to claims 1-5 have been fully considered and are persuasive. Applicant has amended the three independent claims 1, 4 and 5. The amendment narrows the claimed invention. The method and product claimed are now directed to diagnosis of Charcot-Marie-Tooth Disease (CMT) Type 1A (CMT1A) and Hereditary neuropathy with liability to pressure palsies (HNPP). This narrowing of the scope overcomes the scope of enablement rejection. Accordingly the scope of enablement rejection cited in previous Office Action has been withdrawn.

***Claim Objections***

4. Claims 1-5 are objected to because of the following informalities:

Amended claims 1, 4 and 5, identify the two diseases by only the acronyms (CMT1A) and (HNPP). These acronyms in claims 1, 4 and 5 and should be preceded by the full form to recite

---- diagnosing a Charcot-Marie-Tooth disease Type 1A (CMT1A) and Hereditary Neuropathy with liability to Pressure Palsies (HNPP), comprising: ----.

Furthermore, amended claim 1 recites the limitation "-----running **the** PCR amplification ----- " in line 3. Presence of word "the" in the sentence

-----running "**the**" PCR amplification -----is grammatically improper. Deletion of word "the" from this position in claim 1 will resolve that issue. Appropriate correction is required.

Claims 2 and 3 depend from claim 1. Hence claims 1-3 as currently recited share the same problem outlined above for claim 1 and are objected to.

**Suggested Claim 1 Language**

5. The language of amended claim 1 may read as follows:

A method for diagnosing a Charcot-Marie-Tooth disease Type 1A (CMT1A) and Hereditary Neuropathy with liability to Pressure Palsies (HNPP), comprising: running PCR amplification ----.

Appropriate correction is required.

***Reasons for Allowance***

***Allowable Subject Matter***

6. In the Office Action mailed on September 10, 2008 Examiner has provided details of the closest prior art found by Examiner related to the subject matter of independent claims 1, 4 and 5. No references were found teaching or suggesting claims 1, 4 and 5. Since claims 2 and 3 depend from claim 1, hence all claims under examination namely 1-5 contain allowable subject matter. These claims have not yet been allowed for reasons given above.

Examiner contacted Applicant by telephone to request authorization to amend the claim language by Examiner's Amendment. Attorney Edward R. Freedman directed the Examiner to mail an Office Action.

***Conclusion***

7. This application is in condition for allowance except for the following formal matters:

Language of claims 1, 4 and 5 may be amended as indicated above to put these claims in conditions for allowance.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Art Unit: 1637

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUCHIRA PANDE whose telephone number is (571)272-9052. The examiner can normally be reached on 8:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Horlick/  
Primary Examiner, Art Unit 1637

Suchira Pande  
Examiner  
Art Unit 1637